

REMARKS

Please reconsider the application in view of the above amendments and the following remarks.

Disposition of Claims

Claims 1-23 are pending in this application. Claims 1, 10, and 18 are independent. The remaining claims depend, directly or indirectly, from claims 1, 10, and 18.

Examiner Interview

Applicant thanks the Examiner for the telephone interview conducted on January 22, 2003. During the interview, the instant claims were discussed in view of the prior art cited by the Examiner in the Office Action of October 7, 2003. Although no specificity was provided regarding the prior art basis for the rejections, the Examiner did categorize the instant claims as "overly broad." The Examiner further stated that the use of bony landmarks to delineate the metes and bounds of the instant claims was impermissible, despite Applicant's observation that the asserted prior art and Applicant's own issued patent use such language.

During the interview and a telephonic follow-up, Applicant requested that the Examiner suggest language that may be more acceptable in furtherance of the prosecution of this application. The Examiner was unable to provide any such language, although she did state that, after consulting with her supervisor and peers in her subject area, there was agreement that the instant claims were "overly broad."

Rejection(s) under 35 U.S.C § 102

Claims 1-3, 6, and 10-14 stand rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 6,092,314, issued to Rothbart (“Rothbart”). This rejection is respectfully traversed.

Amended claim 1 recites an orthopedic appliance comprising a wedge for placement beneath a toe and *forward of the center of a first metatarsal*, and having a top surface adapted to support the toe and a bottom surface, wherein an angle of inclination between the top surface and the bottom surface of the wedge is between 1 and 60 degrees. Similarly, claim 10 requires that the wedge not extend under the center of a first metatarsal (shown as 36 in the following Figure). In contrast to such devices, Rothbart discloses a forefoot support surface having a back edge positioned **posterior to the first metatarsal (36) but anterior to a plantar surface of the calcaneus (27)** (Col. 6, ll. 30-32).

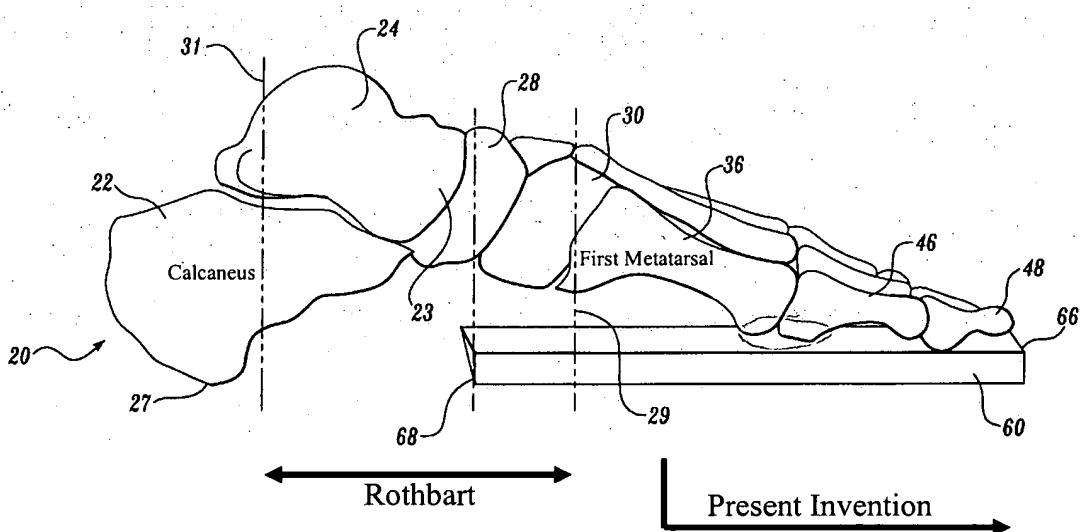


FIGURE 6
(ROTHBART)

As shown in Figure 6, and described at Col. 6, ll. 33-37, “the back edge 68 may

lie in, along or between a reference line 29 at the posterior end of the first metatarsal 36 to a reference line 31 at the anterior end of the plantar surface 27 of the calcaneus 22.” Thus Rothbart is *clearly disclaiming* the location of a wedge according to claims 1 and 10 of the instant application. Furthermore, the Rothbart device clearly lies beneath the center of the first metatarsal *in every embodiment disclosed*, whereas claims 1 and 10 require that the wedge not lie underneath the center of a first metatarsal.

In contrast to Rothbart, the inventions of claims 1 and 10 raise a distal end of a proximal phalanx with respect to a distal end of a first metatarsal, thereby advantageously facilitating plantarflexion of the first metatarsal through the late midstance and propulsive phases of gait (Paragraph 66 of the current application). The invention according to Rothbart instead elevates the first metatarsal and does not facilitate the biomechanical action (described above) that is an advantage of the instant invention.

Furthermore, the Examiner’s assertion that “The size and location of the first metatarsal are dependent on the size of the foot of the user... [t]he wedge of Rothbart ‘314 will be under the phalanges of a toe and not extending under the first metatarsal for someone with a size 16-foot size” (pp. 2-3) is nonsensical. Firstly, the location of the first metatarsal will *never* depend on the size of the foot. The first metatarsal will always lie between the proximal phalanx and the medial cuneiform of a normal foot. Secondly, both Rothbart and the instant application rely on bony landmarks to delineate the metes and bounds of the invention. Accordingly, no matter the foot size, the Rothbart device will always extend to an area between “the posterior end of the first metatarsal 36 [and] the anterior end of the plantar surface 27 of the calcaneus 22” (Figure 6 and col. 6, ll. 33-

37) while the wedge according to claims 1 and 10 will not extend underneath a center of the first metatarsal.

In view of the above, Rothbart fails to show or suggest the present invention as recited in amended claims 1 and 10. Thus, claims 1 and 10 are patentable over Rothbart. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1, 5, and 10-11 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,333,472, issued to Tager (“Tager”). To the extent that this rejection applies to the amended claims, it is respectfully traversed.

Tager discloses a series of differentially-sized geometrically-shaped prosthetic devices to be disposed in footwear. These devices may be situated underneath a region extending from the calcaneum bone of the rear foot (See Fig. 7 and Col. 4, ll. 9-14) to the first metatarsal/first phalanx region (See Fig. 9 and Col. 4, ll. 35-37). In any embodiment of the ‘472 patent that is positioned under a phalanx, the device will also extend underneath a first metatarsal.

In contrast, independent claims 1 and 10 of the instant application, as amended, include the limitation that the orthopedic appliance does not extend under the center of a first metatarsal. Once again, the Examiner asserts that “[t]he size and location of the first metatarsal are dependent on the size of the foot of the user... [t]he wedge of Tager ‘472 will be under the phalanges of a toe and not extending under the first metatarsal for someone with a size 16-foot size” (p. 4). As previously discussed, this statement makes no sense, because ***the location of the first metatarsal will not change based on the size***

of the foot – it will always lie between the proximal phalanx and the medial cuneiform of a normal foot. Finally, there is *absolutely no disclosure or suggestion* in Tager that the wedge according to Tager would lie under the phalanges of a toe, but not extend under the center of a first metatarsal. Should the Examiner maintain the rejection over the Tager reference, Applicant respectfully requests that the Examiner identify with specificity any disclosure by Tager of the claimed position of the orthopedic device.

Accordingly, amended claims 1 and 10 are patentable distinct over the Tager. Claims 5 and 11, which depend from claims 1 and 10, respectively, are similarly patentable. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 103

Claims 4-5 stand rejected under 35 U.S.C. § 103 as being obvious over Rothbart. Claims 4-5 depend from amended claim 1. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As previously discussed, Rothbart *clearly disclaims* the claimed position of the wedge according to amended claim 1. Specifically, the Rothbart device extends well past the center of a first metatarsal, in contrast to the instant claims.

In view of the above, Rothbart fails to show or suggest the present invention as recited in claims 4-5. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7-9, and 15-23 stand rejected under 35 U.S.C. § 103 as being obvious over Rothbart in view of either Brock '927 or Jacoby '046. Claims 7-9 and 15-23 depend

from amended claims 1, 10 and 18, respectively. To the extent that this rejection applies to the amended claims, it is respectfully traversed.

As previously discussed, Rothbart *clearly disclaims* the claimed position of the wedge according to amended claims 1, 10 and 18. Specifically, the Rothbart device extends well past the center of a first metatarsal, in contrast to the instant claims.

Neither Brock '927 nor Jacoby '046 discloses or suggests that which Rothbart fails to teach, specifically the location of a wedge under the phalanges of a toe, and not extending under the center of a first metatarsal. Accordingly, amended claims 1, 10, and 18 are patentable over this combination of references. Claims 7-9 and 15-23, which depend from amended claims 1, 10 and 18, are similarly patentable. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7-9, and 15-23 stand rejected under 35 U.S.C. § 103 as being obvious over Tager or Rothbart in view of either Brock '927 or Jacoby '046. These rejections are respectfully traversed.

As previously discussed, there is *absolutely no disclosure or suggestion* in Tager that the wedge according to Tager would lie under the phalanges of a toe, but not extend under the center of a first metatarsal, as required by amended claims 1, 10, and 18, from which rejected claims 7-9 and 15-23 depend. Furthermore, neither Brock '927 nor Jacoby '046 discloses or suggests that which Tager fails to teach, specifically the location of a wedge under the phalanges of a toe, and not extending under the center of a first metatarsal.

Accordingly, amended claims 1, 10, and 18 are patentable over this combination



of references. Claims 7-9 and 15-23, which depend from amended claims 1, 10 and 18, are similarly patentable. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09166.002001).

Respectfully submitted,

Date: 3/8/04

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